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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/815,869	04/02/2004	Yasuo Sugahara	826.1941	9986
21171 7590 08/21/2008 STAAS & HALSEY LLP SUITE 700 1201 NEW YORK AVENUE, N.W. WASHINGTON, DC 20005				
EXAMINER				
CLARK, DAVID J				
ART UNIT		PAPER NUMBER		
3628				
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08/21/2008		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/815,869

Applicant(s)

SUGAHARA ET AL.

Examiner

DAVID J. CLARK

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on 08 April 2008.
2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☐ Claim(s) 2-8, 10-15, 17-24 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 2-8, 10-15, 17-24 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-8508)
Paper No(s)/Mail Date _____
4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____

DETAILED ACTION

Status of Claims

1. This action is in reply to the RCE application filed on 8 April 2008.
2. Claims 7, 15 and 22 have been amended.
3. Claims 23-24 have been added.
4. Claims 1, 9, and 16 have been canceled by amendment filed on 4 October 2008.
5. Claims 2-8, 10-15, and 17-24 are currently pending and have been examined.

Response to Arguments

6. Applicant's arguments with respect to claims 7, 15, and 22 have been considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 101

7. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

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8. Claims 21, 22, and 24 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Claims 21, 22, and 24 are directed to a series of steps. In order for a series of steps to be considered a proper process under § 101, a claimed process must either: (1) be tied to another statutory class (such as a particular apparatus) or (2) transform underlying subject matter (such as an article or materials). *Diamond v. Diehr*, 450 U.S. 175, 184 (1981); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972). Thus, to qualify as patent eligible, these processes should positively recite the other statutory class to which it is tied (e.g., by identifying the apparatus that accomplishes the method steps), or positively recite the subject matter that is being transformed (e.g., by identifying the product or material that is changed to a different state). Claims 21, 22, and 24 identify neither the apparatus performing the recited steps nor any transformation of underlying materials, and accordingly are directed to non-statutory subject matter.

Claim Rejections - 35 USC § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

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11. Claims 2-8, 10-15, and 17-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Matsubara (US PGP 2002/0138365 A1) in view of Suzuki et al. (US 5,965,858).

Examiner's Note: The Examiner has pointed out particular references contained in the prior art of record within the body of this action for the convenience of the Applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply. Applicant, in preparing the response, should consider fully the entire reference as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the Examiner.

Claim 7:

Matsubara, as shown, discloses the following limitations:

A support apparatus for supporting recycled use of equipment of a user, comprising:

- *an information obtaining unit obtaining equipment information about the equipment to be received from the user (see at least figure 1, "100", "120", "130", "140", "150", "160", and "170" and paragraphs 0016, 0021-0022, and 0031);*
- *a determination unit determining according to information obtained by said information obtaining unit (see at least figure 1)*
- *a location management unit managing a location and a type of the received equipment (see at least figure 1, and paragraphs 0016, 0022, and 0029-31); and*
- *determining a plant which processes the equipment based on ~~the location and the type of the equipment~~ (see at least paragraphs 0016, and 0031, "the consumer can select an appliance disposal business or a way or manner of disposing of the appliance.").*

Matsubara does not disclose a *plant determination unit*. However, Matsubara discloses units that are capable of *determining a plant which processes equipment* (see at least paragraphs 0016 and 0021-0021). It would have been obvious to one of ordinary skill in the art at the time of

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the invention to modify the apparatus of Matsubara to have included a *plant determination unit* to perform the step of *determining a plant which process the equipment* because a computer that determines a plant for a consumer would make the recycling process quicker and more efficient. Matsubara does not disclose the following limitations, but Suzuki et al. however, as shown, does:

- *whether or not treatable articles restriction standards of a receiver of the equipment associated with physical characteristics of the equipment are exceeded* (see at least column 15, lines 38-43);
- *based on whether the restriction standards are exceeded* (see at least column 3, lines 10-25)

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the method of Matsubara with the technique of Suzuki et al. because "It is an object of the present invention to provide a manufactured article recycling system for determining or deciding methods of realizing recycle processings proper for various discarded articles by making it possible to collect, process and furnish speedily a variety of information required for the processings or treatments of the discarded articles, to thereby reduce the amount of wastes and make the much of limited fossil fuel resource." (Suzuki et al. column 1, lines 63-67 – column 2, line 1-3).

Claims 2-6

Matsubara in view of Suzuki et al., as shown, discloses the following limitations:

The apparatus according to claim 7

Moreover, Matsubara, as shown, discloses the following limitations:

(Claim 2) *The apparatus according to claim 7, further comprising:*

- *a charge determination unit determining whether or not the user is to bear a charge for recycle* (see at least paragraph 0006, "an information processing apparatus offers a price of an appliance to be disposed of.").

(Claim 3) *The apparatus according to claim 2, further comprising:*

- *a payment method determination unit determining a method of paying the charge when said charge determination unit determines that the user is to pay the charge (see at least paragraph 0065, "The payment may be made not directly, but via the intermediary at some intermediation service charge. In such a case, the accepting price to be displayed in the list may be determined with the intermediary's service charge taken into account.").*

(Claim 4) The apparatus according to claim 2, further comprising:

- *a calculation unit calculating the charge according to information obtained by said information obtaining unit (see at least paragraph 0010, "The accepting price is determined in accordance with appliance data of the appliance and disposal way data representing a way of disposing of the appliance.").*

(Claim 5) The apparatus according to claim 3, wherein when said charge determination unit determines that the user is to pay the charge, the apparatus first confirms a payment of the charge by the user, and then performs a receiving process (see at least paragraph 0052)..

(Claim 6) The apparatus according to claim 7, wherein said information obtaining unit obtains information from the user over a network (see at least figure 1, "50", and paragraph 0016).

Claims 8 and 23:

Matsubara in view of Suzuki et al., as shown, discloses the following limitations:

The apparatus according to claim 7

Matsubara does not disclose the following limitations, but Suzuki et al. however, as shown, does:

(Claim 8) The apparatus according to claim 7, further comprising:

- *a progress information generation unit generating information about progress of recycling equipment (see at least column 37, lines 57-63).*

(Claim 23) *The apparatus according to claim 7, wherein the physical characteristics comprise weigh and/or size* (see at least column 10, lines 14-23).

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the method of Matsubara with the technique of Suzuki et al. because "It is an object of the present invention to provide a manufactured article recycling system for determining or deciding methods of realizing recycle processings proper for various discarded articles by making it possible to collect, process and furnish speedily a variety of information required for the processings or treatments of the discarded articles, to thereby reduce the amount of wastes and make the much of limited fossil fuel resource." (Suzuki et al. column 1, lines 63-67 – column 2, line 1-3).

Claim 15:

Matsubara, as shown, discloses the following limitations:

A computer readable storage storing a program used to direct a computer to function as:

- *an information obtaining unit obtaining equipment information about the equipment to be received from the user* (see at least figure 1, "100", "120", "130", "140", "150", "160", and "170" and paragraphs 0016, 0021-0022, and 0031);
- *a determination unit determining according to information obtained by said information obtaining unit* (see at least figure 1)
- *a location management unit managing a location and a type of the received equipment* (see at least figure 1, and paragraphs 0016, 0022, and 0029-31); and
- *determining a plant which processes the equipment based on ~~the location and the type of the equipment~~* (see at least paragraphs 0016, and 0031, "the consumer can select an appliance disposal business or a way or manner of disposing of the appliance.").

Matsubara does not disclose a *plant determination unit*. However, Matsubara discloses units that are capable of *determining a plant which processes equipment* (see at least paragraphs 0016 and 0021-0021. It would have been obvious to one of ordinary skill in the art at the time of

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the invention to modify the apparatus of Matsubara to have included a *plant determination unit* to perform the step of *determining a plant which process the equipment* because a computer that determines a plant for a consumer would make the recycling process quicker and more efficient. Matsubara does not disclose the following limitations, but Suzuki et al. however, as shown, does:

- *whether or not treatable articles restriction standards of a receiver of the equipment associated with physical characteristics of the equipment are exceeded* (see at least column 15, lines 38-43);
- *based on whether the restriction standards are exceeded* (see at least column 3, lines 10-25)

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the method of Matsubara with the technique of Suzuki et al. because "It is an object of the present invention to provide a manufactured article recycling system for determining or deciding methods of realizing recycle processings proper for various discarded articles by making it possible to collect, process and furnish speedily a variety of information required for the processings or treatments of the discarded articles, to thereby reduce the amount of wastes and make the much of limited fossil fuel resource." (Suzuki et al. column 1, lines 63-67 – column 2, line 1-3).

Claims 10-14

Matsubara in view of Suzuki et al., as shown, discloses the following limitations:

The storage according to claim 15

Moreover, Matsubara, as shown, discloses the following limitations:

(Claim 10) *The storage according to claim 15, further comprising:*

- *a charge determination unit determining whether or not the user is to bear a charge for recycle* (see at least paragraph 0006, "an information processing apparatus offers a price of an appliance to be disposed of.").

(Claim 11) *The program storage to claim 10, further comprising:*

- *a payment method determination unit determining a method of paying the charge when said charge determination unit determines that the user is to pay the charge (see at least paragraph 0065, "The payment may be made not directly, but via the intermediary at some intermediation service charge. In such a case, the accepting price to be displayed in the list may be determined with the intermediary's service charge taken into account.").*

(Claim 12) The storage according to claim 10, further comprising:

- *a calculation unit calculating the charge according to information obtained by said information obtaining unit (see at least paragraph 0010, "The accepting price is determined in accordance with appliance data of the appliance and disposal way data representing a way of disposing of the appliance.").*

(Claim 13) The storage according to claim 11, wherein when said charge determination unit determines that the user is to pay the charge, the apparatus first confirms a payment of the charge by the user, and then performs a receiving process (see at least paragraph 0052)..

(Claim 14) The storage according to claim 15, wherein said information obtaining unit obtains information from the user over a network (see at least figure 1, "50", and paragraph 0016).

Claim 22:

Matsubara, as shown, discloses the following limitations:

A supporting method of supporting recycled use of equipment of a user, comprising:

- *obtaining equipment information about the equipment to be received from the user (see at least figure 1, "100", "120", "130", "140", "150", "160", and "170" and paragraphs 0016, 0021-0022, and 0031);*
- *determining according to information obtained by said information obtaining unit (see at least figure 1)*

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- *managing a location and a type of the received equipment* (see at least figure 1, and paragraphs 0016, 0022, and 0029-31); and
- *determining a plant which processes the equipment based on ~~the location and the type of the equipment~~* (see at least paragraphs 0016, and 0031, "the consumer can select an appliance disposal business or a way or manner of disposing of the appliance.").

Matsubara does not disclose the following limitations, but Suzuki et al. however, as shown, does:

- *whether or not treatable articles restriction standards of a receiver of the equipment associated with physical characteristics of the equipment are exceeded* (see at least column 15, lines 38-43);
- *based on whether the restriction standards are exceeded* (see at least column 3, lines 10-25)

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the method of Matsubara with the technique of Suzuki et al. because "It is an object of the present invention to provide a manufactured article recycling system for determining or deciding methods of realizing recycle processings proper for various discarded articles by making it possible to collect, process and furnish speedily a variety of information required for the processings or treatments of the discarded articles, to thereby reduce the amount of wastes and make the much of limited fossil fuel resource." (Suzuki et al. column 1, lines 63-67 – column 2, line 1-3).

Claims 17-21:

Matsubara in view of Suzuki et al., as shown, discloses the following limitations:

The method according to claim 22

Moreover, Matsubara, as shown, discloses the following limitations:

(Claim 17) *The method according to claim 22, further comprising:*

- *a charge determination unit determining whether or not the user is to bear a charge for recycle* (see at least paragraph 0006, "an information processing apparatus offers a price of an appliance to be disposed of.").

(Claim 18) *The method according to claim 17, further comprising:*

- *a payment method determination unit determining a method of paying the charge when said charge determination unit determines that the user is to pay the charge (see at least paragraph 0065, "The payment may be made not directly, but via the intermediary at some intermediation service charge. In such a case, the accepting price to be displayed in the list may be determined with the intermediary's service charge taken into account.").*

(Claim 19) *The method according to claim 17, further comprising:*

- *a calculation unit calculating the charge according to information obtained by said information obtaining unit (see at least paragraph 0010, "The accepting price is determined in accordance with appliance data of the appliance and disposal way data representing a way of disposing of the appliance.").*

(Claim 20) *The method according to claim 18, wherein when said charge determination unit determines that the user is to pay the charge, the apparatus first confirms a payment of the charge by the user, and then performs a receiving process (see at least paragraph 0052)..*

(Claim 21) *The method according to claim 22, wherein said information obtaining unit obtains information from the user over a network (see at least figure 1, "50", and paragraph 0016).*

Claim 24:

Matsubara, as shown, discloses the following limitations:

A method, comprising:

- *obtaining the physical characteristics of equipment to be recycled (see at least paragraph 0032, "the consumer enters appliance data including the kind or class of the household appliance 240, e.g. "refrigerator", which the consumer no longer uses or will be disused, the*

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name of the appliance, the **model identification**, the manufacturer, the retail shop at which the consumer bought the appliance, and the date on which the appliance was bought,");

- *designating a recycling facility for processing the equipment based on the comparing* (see at least paragraph 0031, "the consumer can select an appliance disposal business concern or a way or manner of disposing of the appliance.").

Matsubara does not disclose the following limitations, but Suzuki et al. however, as shown, does:

- *comparing the physical characteristics of the equipment with a physical characteristic limitation* (see at least column 15, lines 38-43);

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the method of Matsubara with the technique of Suzuki et al. because "It is an object of the present invention to provide a manufactured article recycling system for determining or deciding methods of realizing recycle processings proper for various discarded articles by making it possible to collect, process and furnish speedily a variety of information required for the processings or treatments of the discarded articles, to thereby reduce the amount of wastes and make the much of limited fossil fuel resource." (Suzuki et al. column 1, lines 63-67 – column 2, line 1-3).

Conclusion

Any inquiry of a general nature or relating to the status of this application or concerning this communication or earlier communications from the Examiner should be directed to **David J. Clark** whose telephone number is **571.270.3938**. The Examiner can normally be reached on Monday-Friday, 9:30am-5:00pm. If attempts to reach the examiner by telephone are unsuccessful, the Examiner's supervisor, **JOHN W. HAYES** can be reached at **571.272.6708**.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://portal.uspto.gov/external/portal/pair> <<http://pair-direct.uspto.gov>>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at **866.217.9197** (toll-free).

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/David J Clark/
Examiner, Art Unit 3628

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Primary Examiner, Art Unit 3628